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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/543,164	04/05/2000	Gregory John Billington	07703-332001	6323

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EXAMINER

SHAPIRO, JEFFERY A

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 03/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/543,164

Applicant(s)

BILLINGTON ET AL.

Examiner

Jeffrey A. Shapiro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 8-20, 25 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-20, 25 and 27-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 8-20, 25 and 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morun (US 5,566,807). Morun discloses the vending machine as follows.

As described in Claims 8-10, 12, 14-18, 20 and 29;

1. a vending machine (1) *operable* to accept payments in units of different denominations, to perform vends, and to dispense change corresponding to the difference between payments and vend prices;
2. a vending machine further *operable* in response to determining that insufficient change is available (see figure 8, element 900), either (i) to dispense a lesser amount of change or (ii) to inhibit a requested vend (see figure 9, element 1002) , depending on whether the difference between the available change and the correct change is equal to or less than a predetermined allowable overpay amount (see figure 7),
3. the vending machine has means permitting alteration of a stored parameter defining the predetermined allowable overpay amount (see figure 5, elements (420 and 430));

As described in Claims 8, 17 and 19-20, 25, 27 and 29;

4. the vending machine is operable to provide a warning indication prior to initiation of a transaction if the available change meets a predetermined criterion (95) (see also col. 11, lines 3-24);

As described in Claim 29;

5. the warning indication is provided only if the allowable overpay amount is non-zero (note that the warning indication as described in col. 11, lines 3-24 will not be provided where the customer submits an amount that is the price of the item desired).

As described in Claim 30;

6. said predetermined criterion is met when the available change is less than the value of the lowest denomination non-refundable payment unit (see figure 8);

As described in Claim 31;

7. said vending machine is operable to provide an "exact change" indication to a customer when a requested vend is inhibited (again, note display (95), thereby providing ability and capability to display such information);

As described in Claims 11, 28 and 32;

8. the machine is operable, when inhibiting a vend, to permit the customer to request a vend at a different price (note that the customer is

capable of requesting a vend at a different price when the machine becomes disabled (1106)).

As described in Claim 13;

10. the circumstances giving rise to the second indication also cause the deposited monetary unit to be refunded (see figures 10a and 10b);

3. Claims 8-10, 12, 14-18, 20 and 29 rejected under 35 U.S.C. 103(a) as being unpatentable over Tedesco et al (US 6,085,888). Tedesco et al discloses the vending machine as follows.

As described in Claims 8-10, 12, 14-18, 20 and 29;

1. a vending machine (100) operable to accept payments in units of different denominations, to perform vends, and to dispense change corresponding to the difference between payments and vend prices;

2. a vending machine further operable in response to determining that insufficient change is available (see figure 8a, element 820), either (i) to dispense a lesser amount of change or (ii) to inhibit a requested vend (see figure 8a, element 822) , depending on whether the difference between the available change and the correct change is equal to or less than a predetermined allowable overpay amount; (Note that the amount of overpay can be reasonably construed as being that amount in excess of the amount needed to purchase an item, and that said price of said item can be reasonably construed as being a predetermined amount.

Therefore, any amount above the item price is predetermined to be an overpay.)

3. the vending machine has means permitting alteration of a stored parameter defining the predetermined allowable overpay amount (see figure 1b, noting processor (144) which necessarily allows input and storage of item prices);

As described in Claims 8, 17 and 19-20, 25, 27 and 29;

4. the vending machine is operable to provide a warning indication prior to initiation of a transaction if the available change meets a predetermined criterion (see figure 8a, elements (820 and 822));

4. Claims 8-10, 12, 14-18, 20 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramsey et al (US 6,055,521). Ramsey et al discloses the vending machine as follows.

As described in Claims 8-10, 12, 14-18, 20 and 29;

1. a vending machine (35) operable to accept payments in units of different denominations, to perform vends, and to dispense change corresponding to the difference between payments and vend prices;

2. a vending machine further operable in response to determining that insufficient change is available (see figures 5, 15a and 15b), either (i) to dispense a lesser amount of change or (ii) to inhibit a requested vend, depending on whether the difference between the available change and the correct change is equal to or less than a predetermined allowable

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overpay amount; (Note that the amount of overpay can be reasonably construed as being that amount in excess of the amount needed to purchase an item, and that said price of said item can be reasonably construed as being a predetermined amount. Therefore, any amount above the item price is predetermined to be an overpay.)

3. the vending machine has means permitting alteration of a stored parameter defining the predetermined allowable overpay amount (note that PC (27) necessarily allows input and storage of item prices);

As described in Claims 8, 17, 19-20, 25, 27 and 29;

4. the vending machine is operable to provide a warning indication prior to initiation of a transaction if the available change meets a predetermined criterion (see figures 5, 15a and 15b);

5. Claims 8-20, 25 and 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (US 6,119,099). Walker et al discloses the vending machine as follows.

As described in Claims 8-10, 12, 14-18, 20 and 29;

1. a vending machine (10) (see col. 3, lines 62 and 63) *operable* to accept payments in units of different denominations, to perform vends, and to dispense change corresponding to the difference between payments and vend prices (note that vending machines are well-known to be able to perform such functions—see also col. 5, lines 35-46 and col. 6, lines 14-30);

2. a vending machine further *operable* in response to determining that insufficient change is available, either (i) to dispense a lesser amount of change or (ii) to inhibit a requested vend (see col. 6, lines 31-44) , depending on whether the difference between the available change and the correct change is equal to or less than a predetermined allowable overpay amount (see col. 6, lines 45-65),
3. the vending machine has means permitting alteration of a stored parameter defining the predetermined allowable overpay amount (see figure 1a, noting input device (14) and upsell database (30));

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 8-20, 25 and 27-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-15 of copending Application No. 09/528,255. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scaling factor



described in the claims of the '255 patent can be reasonably construed by those ordinarily skilled in the art as the functional equivalent of the "overpayment amount" described in the claims of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 8-20, 25 and 27-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-15 of copending Application No. 09/528,255 in view of Morun. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scaling factor described in the claims of the '255 patent can be reasonably construed by those ordinarily skilled in the art as the functional equivalent of the "overpayment amount" described in the claims of the present application. In addition, the claims of Morun disclose an overpayment process.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 8-20, 25 and 27-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-15 of copending Application No. 09/528,255 in view of Walker et al (US 6,119,099). Although the conflicting claims are not identical, they are not patentably distinct from each other because the scaling factor described in the claims of the '255 patent can be reasonably construed by those ordinarily skilled in the art as the functional equivalent of

the "overpayment amount" described in the claims of the present application. In addition, the claims of Walker et al disclose an overpayment process.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

10. Applicant's arguments filed 2/21/02 have been fully considered but they are not persuasive. Regarding Independent Claims 8, 16, 17, 20, 25 and 29, Morun discloses a display (95) which is capable of being used for displaying information. Morun also discloses dispensing a lesser amount of change (see element 1004 in figure 9, for example), or inhibiting a vend (see elements 1001 and 1002 of figure 9). At the very least, it would have been obvious for one ordinarily skilled in the art to use the display means provided by Morun to display such information as it would be expected that in order for the system of Morun to work, it is necessarily so that information would have to be displayed before and after a transaction. For example, note Morun abstract, lines 7-11, col. 2, lines 9-32, col. 9, lines 58-67 and col. 12, lines 16-19. In addition, note Gustin et al (US 5,987,439), figure 20H, for example, which indicates determination of a transaction amount, comparing this amount to credit available in an account or by cash, and indicating a similar process as Applicant's. Note also, Gustin et al, figure 21F, for example, indicating the transaction price and amount inserted into the machine. This screen could be construed as a warning to a customer that less than the transaction amount has been deposited. See also figure 16a, elements 522, 528 and 536 may also be construed as warnings that are used before, during and after a transaction has been

made. Note that figure 17 discloses elements (572, 576, 578, 580, and 586 which may all be construed as warnings or indications to the customer during the transaction process, where he is given the ability to change an amount of cash to receive. Further regarding Claim 20, note that it would again be expedient for one ordinarily skilled in the art to allow a customer to choose another product based upon the information necessarily required for the process of Morun to work, since it can be envisioned that a customer, instead of paying a certain amount over a particular price for a particular product, might choose another product not requiring an overpay amount. Regarding Claim 25, it would also be obvious to one ordinarily skilled in the art to provide an overpay amount which would be in response to one particular coin, since, for example, the one dollar US coin has been used in vending machines. At the very least, as inflation over time causes prices to rise, it would be envisioned that a vending machine would have to accept one dollar coins in order to be more efficient to a customer attempting to purchase higher-priced items.

*Applicant asserts that a display means arranged to give first and second indications that insufficient change may be available to a customer is not obvious over Morun, for example. However, it is noted that a "change empty" or "bills only" LED display message is routinely found on vending machines. Note also Walker, cited above, which has an elaborate scheme of warnings and identifications which appear to match Applicants' limitations found in the independent claims. It is noted that the prior art cited above, Morun and Walker et al in particular, appear to read on the independent*

*claims, as currently written and reasonably broadly construed, as described above.*

*Therefore, the rejection of Claims 8-20, 25 and 27-32 is maintained.*

### **Conclusion**

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Walker et al (US 6,298,329 B1; US 6,230,150 B1; US 6,397,193 B1; US 6,298,331 B1; US 6,341,268 B2; US 2001/0056376 A1 and US 2002/0161653 A1) and Hayashi et al (US 4,347,924 and US 4,616,323).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (703)308-3423. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

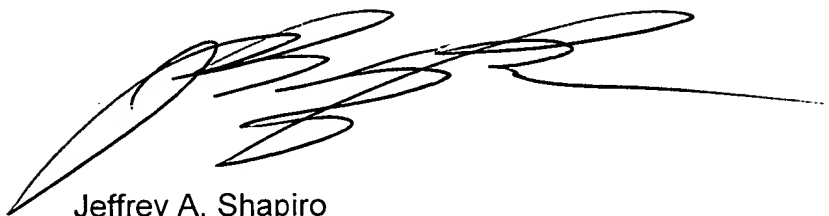
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald P. Walsh can be reached on (703)306-4173. The fax phone numbers for the organization where this application or proceeding is assigned are (703)306-4195 for regular communications and (703)306-4195 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

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A large, stylized handwritten signature in black ink, likely belonging to Jeffrey A. Shapiro.

Jeffrey A. Shapiro  
Patent Examiner,  
Art Unit 3653

A small, stylized handwritten signature in black ink, likely belonging to Donald F. Walsh.

DONALD F. WALSH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

February 27, 2003